



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MORRISON & FOERSTER LLP
755 PAGE MILL RD
PALO ALTO CA 94304-1018

MAILED

MAY 27 2010

OFFICE OF PETITIONS

In re Application of :
JIAO et al. : DECISION ON APPLICATION
Application No. 10/618,338 : FOR
Filed: July 11, 2003 : PATENT TERM ADJUSTMENT
Atty Docket No. 146392002520 :

This is a decision on the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705, filed December 23, 2009, which is properly treated under the provisions of 37 CFR 1.705(b). Applicants submit that the correct patent term adjustment to be indicated on the patent is three hundred forty (340) days, not one hundred sixty-nine (169) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction partly on the basis that the Office will take in excess of three years to issue this patent.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term. Patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined.

Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

With respect to applicants' other basis for filing this paper, the application for patent term adjustment is DISMISSED.

¹ For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

On September 28, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 169 days. On December 23, 2009, applicants timely submitted the instant application for patent term adjustment with payment of the issue fee.

Applicants assert that the reduction pursuant to 37 CFR 1.704(b) of 37 days for the filing of the response to the Notice to File Missing Parts mailed October 17, 2003, is not merited.

Applicants contend that they submitted a complete response on December 15, 2003, within three months of the mail date of the Notice to File Missing Parts. Applicants aver that the response to the Notice to File Missing Parts included all of the documents necessary to fully comply with the Notice.

A review of the record indicates that the Office mailed a Notice to File Missing Parts of Nonprovisional Application on October 17, 2003, requiring the submission of a properly signed oath or declaration in compliance with § 1.63, the statutory basic filing fee, a late declaration surcharge, and additional claim fees. On December 15, 2003, the Office received the statutory basic filing fee, the late declaration surcharge, the additional claim fees, and a four-page declaration. On January 30, 2004, the Office mailed a Notice of Incomplete Reply acknowledging receipt of the reply on December 15, 2003, and advising applicants that the declaration was missing the signatures of inventors Wong and Wen and that it did not identify the citizenship of each inventor. The Notice informed applicants that they must submit a complete reply in the form of a new oath or declaration in compliance with § 1.63 within the extendable period set forth in the Notice of October 17, 2003, to avoid abandonment.

On February 23, 2004, applicants submitted a response to the Notice of Incomplete Reply asserting that the Notice was sent in error. Applicants argued that they submitted a complete reply on December 15, 2003, which included two declarations (8 pages) that identified the citizenship of each inventor and were signed by all of the joint inventors. In support of the assertion, applicants submitted a copy of the response to the Notice to File Missing Parts, the attached postcard copy, and a certificate of mailing dated December 12, 2003. Applicants asserted that the attached postcard copy and certificate of

mailing showed that a complete response, including the two declarations (8 pages), was mailed to the USPTO on December 12, 2003, and was timely filed.

A review of the application history reveals that applicants were properly assessed a delay of 37 days pursuant to 37 CFR 1.704(b) for the filing of the response to the Notice to File Missing Parts. Calculation of applicants' delay is based on the date of receipt of the response in the Office.

Initially, the Office notes that the copy of the postcard receipt submitted by applicants on petition does not contain a USPTO date-stamp of December 15, 2003, but rather shows a date-stamp of February 23, 2004. Therefore, the postcard receipt provides prima facie evidence of receipt in the Office of all items listed thereon on the date stamped by the USPTO, February 23, 2004. Thus, the postcard receipt cannot be used to establish that the two declarations were received by the Office on December 15, 2003. Furthermore, applicants' attention is directed to 37 CFR 1.703(f), which provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. MPEP 2731 states:

The date indicated on a certificate of mailing is used only to determine whether the correspondence is timely (including whether any extension of the time and fee are required) so as to avoid abandonment of the application or termination or dismissal of proceedings. The actual date of receipt of the correspondence in the Office is used for all other purposes. See 37 CFR 1.8(a). Thus, while the date indicated on any certificate of mailing or transmission under 37 CFR 1.8 will continue to be taken into account in determining timeliness, the date of filing (37 CFR 1.6) will be the date used in a patent term adjustment calculation.

Therefore, applicants have not established that a complete response to the Notice to File Missing Parts was received in the Office until February 23, 2004. Thus, the period of adjustment was properly reduced by 37 days, the number of days in the period beginning on the day after the date that is three months after the date of mailing of the Notice to File Missing Parts, January 18, 2004, and ending on the date the complete reply was

filed, February 23, 2004. As applicants failed to engage in reasonable efforts to conclude prosecution of the application, the period of reduction of 37 days is warranted and will not be removed.

Next, applicants dispute the periods of reduction of 74 days and 60 days for the filing of Request for Continued Examination (RCE) on June 29, 2007, and November 18, 2008, respectively. Specifically, applicants assert:

[A]n Office Action was issued on January 16, 2007. Applicants responded in a timely manner to [the] Office Action on April 13, 2007. Therefore, based on 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b), there was no delay on the Applicants' part. An Advisory Action was issued June 4, 2007 in response to Applicants' response.

Applicants filed a Request for Continued Examination (RCE) on June 29, 2007 in response to the Advisory Action. However, the USPTO's calculation subtracted 74 days from the Applicants from the time of the Office Action issuance to the filing of the RCE. Under 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b), Applicants have responded in a timely manner and as such, the deduction should be 0 days. In view of the foregoing, Applicants respectfully request reconsideration and correction to reflect that the Applicants' delay is 0 days.

[T]he USPTO issued an Office Action on June 19, 2008. Applicants responded in a timely manner on August 19, 2008. Therefore, based on 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b), there was no delay on the Applicants' part. The USPTO issued an Advisory Action on October 17, 2008. Applicants filed a response with RCE on November 18, 2008. Again, the USPTO subtracted 60 days from the Applicants from the time of the Office Action issuance to the filing of the RCE. Under 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b), Applicants have responded in a timely manner and as such, the deduction should be 0 days. In view of the foregoing, Applicants respectfully request reconsideration and correction to reflect that the Applicants' delay is 0 days.

The Office has considered applicants' arguments, but finds them unpersuasive.

37 CFR 1.704(b) states that an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed.

37 CFR 1.703(a)(3) states that the period of delay is the number of days beginning on the date after the date that is four months after the date a reply in compliance with 37 CFR 1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first. "A reply under 37 CFR 1.113 is a reply to a final Office action, and a reply in compliance with 37 CFR 1.113 is a reply that cancels all of the rejected claims and removes all outstanding objections and requirements or otherwise places the application in condition for allowance." MPEP 2731. "Any amendment after final that does not cancel all of the rejected claims and remove all outstanding objections and requirements or otherwise place the application in condition for allowance is not a reply in compliance with 37 CFR 1.113(c)." Id.

Following a final Office action, the period at issue is first the period it takes applicant to file a reply in compliance with 37 CFR 1.113(c). Until such a reply is filed, applicant is subject to entry of a period of reduction for failure to engage in reasonable efforts to conclude processing or examination within the meaning of 37 CFR 1.704(b). The mailing of an Advisory Action is an indication that the reply filed did not comply with 37 CFR 1.113(c). It is not the Office's action within the meaning of 37 CFR 1.702(a)(2) and does not toll the period of applicant delay.

In this instance, applicants' reply on April 13, 2007 to the final Office action of January 16, 2007, as well as the reply on August 19, 2008 to the final Office action of June 19, 2008, were not in accordance with 37 CFR 1.113(c). Accordingly, the periods of reduction in patent term adjustment for applicant delay pursuant to 37 CFR 1.704(b) of 74 days (beginning on April 17, 2007 and ending on June 29, 2007) and 60 days (beginning on September 20, 2008 and ending on November 18, 2008), are warranted for failure to engage in reasonable efforts to conclude processing or examination.

In view thereof, the determination of patent term adjustment remains 169 days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions